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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/803,173
Filing Date: March 09, 2001
Appellants(s): CHENG, CHONG SENG

WARREN S. HEIT (REG. NO. 36,828)

For Appellants

EXAMINER'S ANSWER

This is in response to the appeal brief filed 07 May 2012 appealing from the Office
action mailed 05 May 2011.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

A prior appeal in the above-identified U.S. Patent Application, Appeal 2008-006002, was decided by the Board on 20 November 2009. Appellants had further filed a Request for Rehearing of the Board's decision dated 20 November 2009 in which the Board denied the request on 24 May 2011.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 22-24 and 26-30 are pending in the application. Claims 22-24 and 26-30 were rejected in the final Office Action mailed May 5, 2011. Claims 1-21 and 25 have been cancelled. Claims 22-24 and 26-30 are on appeal.

(4) Status of Amendments After Final

The examiner has no comment on the Appellants' statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the Appellants' statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the Appellants' brief.

(8) Evidence Relied Upon

US 6,407,949	MARGALIT ET AL.	06-2004
US 6,407,949	JHA ET AL.	06-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112 (First Paragraph)

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "... having a memory space at least as large as the memory space of the magnetic disk or CD." The specification fails to indicate a minimum capacity of memory space within the device or even relate the amount of memory space in the portable USB device to the amount of memory which would be in a magnetic disk or a CD (Please refer to page 8, lines 18-21, of the decision by the Board of Appeals and Interferences dated 11/20/2009 where it is set forth that "[if] claim 22 were to specify that the 'capacity' refers to some minimum amount of memory by a

number such as 1.44Mb, we would tend to agree with the Examiner that the subject matter is not supported by the disclosure").

Claim Rejections - 35 USC § 112 (Second Paragraph)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, Appellants compare the size of the memory to a magnetic disk or a CD. However, the amount of memory a CD or a magnetic disk does not particularly point out or distinctly claim the subject matter which applicant regards as his invention because the size of these devices could vary. The limitation "... to serve as an alternative to a magnetic disk or CD", does not further help to define the size of a magnetic disk or CD because a storage medium of even a single bit, byte or etc. can be used to serve as an alternative to a magnetic disk or CD (See Decision on Request for Rehearing dated May 24, 2010 pages 2-4). Therefore, the size of memory of a magnetic disk or CD could vary greatly.

Secondly, Appellants state "... capable of storing software for installation to the computer or of receiving and storing..." This does clearly articulate whether the invention actually does this or is simply capable of doing this. In being capable of storing software, it does not necessarily mean that the memory device actually does

store software, it simply means it has the ability to do so. Under the broadest reasonable interpretation, by having memory in the device would enable a device to be capable of storing software.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 22-24 and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Margalit et al. (US 6,748,541) (herein after Margalit).

CLAIM 22

As per claim 22, Margalit teaches a unitary portable data storage device (fig. 1, 10) which can be directly plugged into a universal serial bus (USB) socket of a computer (col. 5, lines 27-30) and which is operative to function as an alternative to a magnetic disk or compact disk (CD) (col. 7, lines 12-16), and which is capable of storing software for installation to the computer or of receiving and storing user's data present in the computer (col. 7, lines 12-16), the unitary portable data storage device comprising:

a USB plug integrated into the unitary portable data storage device without an intervening cable capable of coupling the unitary portable data storage device directly to a USB socket on a computer (col. 5, lines 27-30);

an interface allowing the unitary portable data storage device to communicate via the USB protocol and being coupled to the USB plug (col. 4, lines 42-49);

a non-volatile solid-state memory, said memory being non-removable from the unitary portable data storage device and having a memory space at least as large as the memory space of a magnetic disk or CD to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD (col. 4, lines 38-41, See Board of Appeals and Interferences decision dated 11/20/2010 which on page 8 states "we do not see why the capacity, if interpreted to refer to an amount of memory, requires more than a single byte (or bit) of memory and furthermore on page 16 of the decision the Board continues to state "Margalit also teaches that the plug device can store confidential medical information. *Id.* at col. 7, 11.13-16. The reference thus discloses, or at least suggests, a memory storage capacity sufficient to meet the (unspecified) amount of storage capacity asserted by Appellants."); and

a memory controller, the memory controller being coupled between the interface and the memory to control storage of data received via the USB plug in the memory in a manner to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD (As illustrated in fig. 1, with CPU being between the interface and user data memory), the data including at least user data that is not authorization data (col. 7, lines 12-16).

CLAIM 23

As per claim 23, Margalit teaches wherein the memory controller is non-removable from the unitary portable data storage device (As illustrated in col. 6, line 61 – col. 7, line 4 illustrates a non-removable memory controller within the definition of non-removable as defined and described in applicant's remarks and arguments dated 03/21/2005).

CLAIM 24

As per claim 24, Margalit teaches wherein the non-volatile solid-state memory is a flash memory (col. 4, lines 38-42).

CLAIM 26

As per claim 26, Margalit teaches wherein the memory controller comprises a micro-controller (col. 4, lines 23-26).

CLAIM 27

As per claim 27, Margalit teaches wherein the micro-controller includes a read-only memory which stores a program to control the operation of the micro-controller (col. 4, lines 35-37 and col. 10, lines 46-50).

CLAIM 28

As per claim 28, Margalit teaches wherein the unitary portable data storage device is sufficiently compact to maximize portability (col. 5, lines 63-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 29 and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Margalit as applied to claim 22 above, and further in view of Jha et al. (US 6,407,949) (herein after Jha).

CLAIM 29

As per claim 29, Margalit teaches all the limitations of claim 22 as described above and further teaches wherein the non-volatile solid state memory is accessible via the USB plug (as illustrated in fig. 1).

Margalit does not explicitly teach wherein the non-volatile solid-state memory is divided into a plurality of zones, each of the plurality of zones being selectively accessible in response to a zone selection.

However, Jha teaches wherein the non-volatile solid-state memory is divided into a plurality of zones, each of the plurality of zones being selectively accessible in response to a zone selection (As illustrated in fig. 4 and further described in col. 10, line 60 – col. 11, line 17)

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the zoned password protection of Jha with the flash memory device

of Margalit in order to prevent inadvertent erasures or reprogramming of portions of the flash memory (col. 11, lines 17-19).

CLAIM 30

As per claim 30, the combination of Margalit and Jha teaches wherein one or more of said plurality of zones require a unique password (Jha, fig. 4) received via the USB plug for access (Margalit, col. 5, lines 20-30 describes wherein information is transmitted to the device via the USB plug).

(10) Response to Argument

1. Request to Correct Inventorship

A Request to Correct Inventorship to add inventor Teng Pin Poo was filed on May 20, 2004. The request is generally fulfilled by the Office of Petitions and therefore, Examiner has no comment on the Request to Correct Inventorship at this time (MPEP 605.04(g) Correction of Inventorship).

2. Rejection of claim 22 under 35 U.S.C. §112, first paragraph

Claim 22 stands rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. In specific Examiner has indicated that Appellants' disclosure as originally filed does not support the limitation "...having a memory space at least as large as the memory space of the magnetic disk or CD."

Appellants submit that support for this limitation can be found on page 5, lines 11-14 of Appellants' disclosure. This portion of the disclosure specifically states "[t]he

device 10 also includes a USB socket 8 that is coupled directly to the USB plug 1 and permits the other USB devices to be coupled to the USB via the device 10. For example, if a user wishes to increase memory space, a USB plug 1 of a second memory device 10 may be connected to the USB socket 8." Appellants further indicates that further support can be found on page 1, lines 13-22 of Appellants' disclosure and on page 2, lines 6-11 of the disclosure, which states that "[a]n advantage of the invention...is to provide a portable data storage device which...does not include moving parts or require a mechanical drive mechanism to read the data..." Appellants suggest that this limitation when read in light of page 1, lines 13-22 of the specification identifying then-existing storage devices such as magnetic disks and CD-ROM as deficient due to, for example, their "bulky and/or delicate parts" provides support for the claim limitation. It appears that Appellants are attempting to submit that in order to serve as an effective replacement for magnetic disks and CD-ROMs, the claimed portable data storage device must have a memory space that is at least as large as a magnetic disk or CD-ROM.

Examiner respectfully disagrees with Appellants. It is unclear why it is necessary for the portable storage medium as claimed to be of a particular size. For example if the magnetic disk or CD ROM was used to store a byte of information or even a bit, a portable storage medium of the size of a byte or bit would be able to perform the necessary functions to serve as an alternative (BPAI decision issued 20 November 2009; page 8, lines 11-16).

Appellants also submit that at the time of the invention "it was well known that a memory size of a typical magnetic disk was approximately one and a half megabytes." This therefore appears to indicate that Appellants would like the "memory space" to be at least one and a half megabytes in size. The Board's Decision on the Request for Rehearing issued 20 January 2010 states that because the Specification did not define or indicate some minimum amount of memory capacity to enable the portable data storage device to serve as "an alternative to a magnetic disk or CD" we are not persuaded that the broadest reasonable interpretation of "sufficient capacity" is limited to mean an amount of memory equal to or greater than 1.44 megabytes (Also see BPAI decision issued 20 November 2009, page 8, lines 17-20). While the Examiner acknowledges that the exact language "sufficient capacity" as recited previously is not recited in the claims as they stand before the Board today, the Examiner is suggesting that the language "having a memory space at least as large as the" suggests a required minimum capacity as required by the previously presented claim.

Appellants further submits that because the memory 4 is capable of being divided into at least two zones, where one zone can be used for storing a user's data, the memory 4 necessarily has sufficient memory space to enable user data to be stored in a portion (zone) of the memory. It appears that Appellants are arguing that by having multiple zones, one of which is used for storing a user's data, that it provides support for "having a memory space at least as large as the memory space of the magnetic disk of CD." However, as stated above, it is not clear why the amount of user data being stored has to be greater than merely a bit or a byte of data (BPAI decision issued 20

November 2009, page 8, lines 11-16). Therefore, would not necessarily provide adequate written description for the memory space as recited.

Furthermore, when giving the claims the broadest reasonable interpretation the claim language does not necessarily require that the memory space be as large as the total capacity of a magnetic disk or CD or even some minimum amount. The claims, given the broadest reasonable interpretation, can be construed such that "the memory space of the magnetic disk or CD" is just enough in size to store a piece of data which could be written to the magnetic disk or CD. This piece of data could be a byte or even a bit and therefore, the memory space could simply be of this size. As a result, it would be reasonable to interpret "the memory space of the magnetic disk or compact disk" to be size of a byte or even a bit. While it does appear that Appellant would like this memory space to be of the total size of the magnetic disk or CD, it is not required as this limitation is recited and further would not appear to be supported by Appellants' disclosure (BPAI decision issued 20 November 2009, page 8, lines 5-13).

As previously claimed, argued and decided, Appellants are again attempting to claim a minimum amount of memory (i.e. the size of a magnetic disk and/or CD) to serve as an alternative to a magnetic disk or CD by reciting "...having a memory space at least as large as the memory space of the magnetic disk or CD." For the foregoing reasons and the reasons stated in the prior Board's decision of 20 November 2009 and the Decision of the Request for Rehearing issued 20 January 2010, Examiner respectfully requests the Board to sustain the 35 U.S.C. §112, first paragraph rejection for.

3. Rejection of claim 22 under 35 U.S.C. §112, second paragraph

Claim 22 stands rejected under 35 U.S.C §112, second paragraph, as being indefinite. In specific, the Examiner has indicated the limitation "...having a memory space at least as large as the memory space of a magnetic disk or CD" does not particularly point out or distinctly claim the subject matter which Appellants regard as his invention. This limitation is indefinite because it refers to the memory space of the portable storage device having a size at least the size of a magnetic disk or CD which can vary depending on the specific disk used. Firstly, the claims as recited actually refer to two different types of storage devices, a magnetic disk and a CD which generally have at least two different storage capacities.

Furthermore, Appellants submit that a memory size of a magnetic disk was approximately one and half megabytes. Magnetic disks are storage devices used to store data in hard drives, floppy drives, zip drives, etc., which all vary in the amount of memory space they have. Therefore, even assuming that Appellants' submission was true, it surely cannot be said that all magnetic storage devices or CDs had a memory space of one and a half megabytes. In *Ex Parte Brummer*, the Board has held that a limitation in a claim to a bicycle that recited "said front and rear wheels so spaced as to give a wheelbase that is between 58 percent and 75 percent of the height of the rider that the bicycle was designed for" was indefinite because the relationship of parts was not based on any known standard for sizing a bicycle to a rider, but on a rider of unspecified size. *Ex parte Brummer*, 12 USPQ2d 1653 (Bd. Pat App. & Inter. 1989). The claims as presented by Appellants in this case, describe the size of the memory

space of a portable storage device using the unspecified memory space of a magnetic disk or CD. As a result, the Examiner respectfully requests the Board to sustain the 35 U.S.C. §112, second paragraph rejection for the aforementioned reasons.

Claim 22 also stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite with respect to the limitation "...capable of storing software for installation to the computer or of receiving and storing..."

Appellants argue that one of ordinary skill in the art would understand that "capable of storing software" as used in the preamble of claim 22 is definite in expressing the portable data storage device's ability to store software if a user so chooses. Examiner respectfully disagrees. Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP 2111.04). Here, as Appellants state, "capability" refers to the ability to store data is a user chooses to do so. Therefore, this indicates a step of storing is made optional and not required to be performed. Examiner respectfully requests that this limitation not be given patentable weight for the aforementioned reasons and the 35 U.S.C. §112, second paragraph be sustained.

4. Rejection of claims 22-24 and 26-28 under 35 U.S.C. §102(e)

Claims 22-24 and 26-28 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,748,541 to Margalit et al. Appellants traverse.

Appellants argue that Margalit does not disclose a data storage device that is able to serve as an alternative to a magnetic disk or CD. Appellants further submit that Margalit does not disclose a data storage device with a memory having a memory size at least as large as the memory size of a magnetic disk or CD.

Examiner respectfully disagrees. In giving the claims the broadest reasonable interpretation, Margalit teaches a storage device that is able to serve as an alternative to a magnetic disk or CD (See col. 7, lines 12-16 and also see col. 4, lines 28-37). Margalit teaches the storage of firmware memory and user data in non-volatile storage (col. 4, lines 35-42) and places no limitation on the storage capacity of the firmware memory 50 (BPAI decision issued 20 November 2009, page 16, lines 3-8). A magnetic disk or CD is merely a storage means to store data. The portable storage device is a storage device which is also used to store data. Therefore the portable storage device of Margalit functions as an alternative to storing data on either a magnetic disk or CD. As the claim is recited, the magnetic disk or CD is not actually required, but the claims do require a storage device which can function as an alternative, which in this case would be merely to store data. Thus, the reference thus discloses or at least suggests, a data storage device which is able to serve as an alternative to a magnetic disk (BPAI decision issued 20 November 2009).

Margalit further teaches a data storage device with a memory having a memory space at least as large as the memory space of a magnetic disk or CD. The Appeal Brief states "Margalit also does not disclose a data storage device with a memory having a memory size at least as large as the memory size of a magnetic disk or CD."

(Appeal Brief filed 07 May 2012, page 10, lines 3-5) However, this limitation as recited in Appellant's brief is not present in the claims as they stand before the Board. The actual language of the claim is "having a memory space at least as large as the memory space of a magnetic disk or CD to enable the unitary portable storage device to serve as an alternative to a magnetic disk or CD." When giving the claims the broadest reasonable interpretation the claim language does not necessarily require that the memory space be as large as the total capacity of a magnetic disk or CD or even some minimum amount. The claims, given the broadest reasonable interpretation, can be construed such that "the memory space of the magnetic disk or CD" is just enough in size to store a piece of data which could be written to the magnetic disk or CD. This piece of data could be a byte or even a bit and therefore, the memory space could simply be of this size. Therefore, it would appear to be reasonable to interpret "the memory space of the magnetic disk or compact disk" to be size of a byte or even a bit. While it does appear that Appellant would like this memory space to be of the total size of the magnetic disk or CD, it is not required as this limitation is recited and further would not appear to be supported by Appellants' disclosure (BPAI decision issued 20 November 2009, page 8, lines 5-13). Therefore, Margalit does teach wherein the portable storage device has enough memory space to hold firmware along with user data (col. 4, lines 35-42 and further col. 7, lines 12-16) and as a result teaches the limitation in question.

5. Rejection of claims 29 and 30 under 35 U.S.C. § 103(a)

Claim 29 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Margalit in view of US Patent No. 6,407,949 to Jha et al. Appellants traverse.

Appellants submit Jha does not disclose the limitation "the non-volatile solid state memory is divided into a plurality of zones, each of the plurality of zones being selectively accessible in response to a zone selection received via the USB plug. Examiner respectfully disagrees. Margalit teaches wherein the non-volatile solid state memory is accessible via the USB plug (Margalit, fig. 1). Jha teaches wherein the non-volatile solid state memory is divided into a plurality of zones, being selectively accessible in response to zone selection (As illustrated in fig. 4 and discussed in col. 10, line 60-col. 11, line 17). In specific, Jha teaches storing passwords associated with different portions of a flash memory array (col. 10, lines 60-62). In order to write or erase from a zone a password must be entered for the corresponding portion of memory (col. 10, line 63-col. 11, line 4). Therefore each command specifies a password along with an identification of the memory to be access. As a result, when combined, the combination of Margalit and Jha teach the limitations of the claimed invention.

Appellants also submit that one of ordinary skill in the art would have no reason to modify the FCCS device of Margalit to include the flash memory divided in to a set of flash macros, as disclosed by Jha.

Examiner respectfully disagrees. In Appellant's brief, Appellant states that "the independently accessible flash macros of Jha are advantageous in a cellular telephone

application because flash memory in an ASIC in a cellular telephone may need to be accessed "much more quickly than is required in other applications." (Appeal Brief filed 07 May 2012, page 15, lines 3-8) This in it of itself would be motivation because it would provide faster access to flash memory. Even ignoring the motivation that Appellant has provided, the password protected zones prevent inadvertent erasures or reprogramming of portions of the flash memory (Jha, col. 11, lines 17-19; Also see BPAI decision issued 20 November 2009, page 10, lines 5-8).

For the foregoing reasons, Examiner respectfully requests the Board to affirm the Examiner on all grounds of rejection.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Gurtej Bansal/

Examiner, Art Unit 2189

Conferees:

/Jared I Rutz/

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